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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,442	07/23/2003	Frank Charles Scozzafava	0003/001	1836

7590 01/19/2005

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/626,442

Applicant(s)

SCOZZAFAVA, FRANK CHARLES

Examiner

Ruth C Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/23/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, drawn to a kit apparatus, classified in class 63, subclass 19.4.

II. Claims 11-19, drawn to a method for forming a temporary body art, classified in class 156, subclass 598.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in materially different process of use since the independent claim of the product does not include a first exposed adhesive side and a backing side. The method of use can be to apply the transfer sheet to the body and then applying the sprinkable decorative material over the transfer sheet.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Cynthia L. Smith on 10 January 2005 a provisional election was made without traverse to prosecute the invention of I, claim 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

3. The information disclosure statement filed 23 July 2003 has been considered as for this Office Action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartelius et al. (US 6,035,857).

A kit apparatus for decorating a human body comprises a patterned transfer sheet (C. 2, L. 59-61) and a plurality of capsules (90,92) (Abstract). The transfer sheet has a plurality of releasable themed ornamental patterns thereon since it is inherent that

Art Unit: 3677

the stickers have an ornamental pattern. The plurality of capsules contains one or more sprinkle-able decorative materials (C. 2, L. 56-59).

The sprinkle-able decorative material is selected from the group consisting of colored sand, colored cosmetic grade glitter and glow-in-the-dark powder (C. 2, L. 56-59).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartelius.

Hartelius discloses a kit for decorating a human body having all the limitations mention above in paragraph 3 for the rejection of claim 1. Hartelius fails to disclose that the kit further comprises an instruction sheet. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have an instruction sheet with the kit since it is well known in the art at the time the invention was made to include an instruction sheet in the package enclosing the kit on to assemble the kit.

Hartelius also fails to disclose that the plurality of releasable themed ornamental pattern comprises geometric shapes, holiday themed shapes or erotic themed shapes. However, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have geometric shapes, holiday themed shapes or erotic themed shapes as the themed ornamental patterns since it is well known in the art at time of applicant's invention to have different themes to be used in accordance with the preferences of the user.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartelius in views of Abraskin et al. (US 2003/0131862 A1).

Hartelius discloses a kit for decorating a human body having all the limitations mention above in paragraph 3 for the rejection of claim 1. Hartelius also disclose that the kit can be used to store other accessories and glitter is given as one example of accessories. Hartelius fails to disclose that the accessories can be a plurality of ornamental studs. However, Abraskin teaches the use of a plurality of ornamental studs (10) for decorating a human body (20,22). The use of the plurality of ornamental studs serves to decorate as part of a fashion trend (Paragraph 0003). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a plurality of ornamental studs as taught by Abraskin in the kit disclosed by Hartelius since the ornamental studs are well known to be use in order to improve the appearance of the human body by decorating the body.

The plurality of ornamental studs taught by Hartelius is selected from the group consisting of metal spikes having a flat back surface, metal studs having a flat back surface, and pseudo-jewels (10) having a flat back surface.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartelius in views of Komuta et al. (Us 2002/0106493 A1)

Hartelius discloses a kit for decorating a human body having all the limitations mention above in paragraph 3 for the rejection of claim 1. Hartelius fails to disclose any details of the patterned transfer sheet and therefore, it fails to disclose that the sheet further comprises a double-sided medical grade adhesive material sandwiched between two release liners. However, Komuta teaches a transfer sheet for a nail decoration. The patterned transfer sheet comprises a double-sided medical grade adhesive material (2,3,4) sandwiched between two release liners (1,6). The sheet is provided to improve the appearance of the user since it provides a decoration (Paragraph 0002 and 0003). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a double-sided medical grade adhesive material (2,3,4) sandwiched between two release liners as the transfer sheet in accordance with Komuta teachings in the kit disclosed by Hartelius. Doing so, improve the appearance of the user since it provides a decoration that can be sized to the area of the body where it is being applied.

The patterned transfer sheet is die cut to form the plurality of releasable themed ornamental patterns (Figs. 2, 4 and 8-10).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fleming (US 4,533,051), Straub (US 4,824,702), Hayes (US 5,269,330), Traub et al. (US 5,782,379), Jang (US 5,975,087), Hartelius et al. (US 6,065,478), Chang (US 6,328,039 B1), Amen-Ra A (US 6,472,039 B1) and House (US 2002/014912 A1) are cited to show state of the art with respect to kit for decorating a human body that has some of the features being claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or



amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

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\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

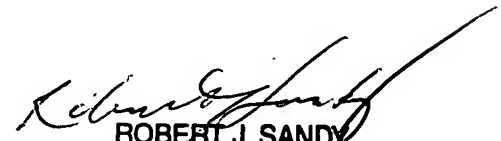
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

RCR  
rcr

January 10, 2005

  
ROBERT J. SANDY  
PRIMARY EXAMINER